

REMARKS

Claims 1-34 remain in this application. Claim 28 has been amended to correct a typographical error. Reconsideration of the claims in view of the following remarks is respectfully requested.

Rejection under 35 U.S.C. § 102

Claim 29 was rejected over O'Brien (6,351,776). This rejection is respectfully traversed.

Claim 29 recites:

A user internet file system comprises:
a received folder that contains folders *representing files and folders that have been shared with a user and the names of those who shared the files and folders with the user*; and
a friends folder that contains the *user's objects and community folders that contain information that are of interest to the user*. (emphasis added)

MPEP § 2131 provides that "[t]o anticipate a claim, the reference must teach **every** element of the claim...." (emphasis added) However, O'Brien neither teaches nor shows a received folder or a friends folder as set forth in claim 29. The received folder "contains folders representing files and folders that have been shared with a user and the names of those who shared the files and folders with the user," and the friends folder "contains the user's objects and community folders that contain information that are of interest to the user." O'Brien is devoid of such teaching.

The Examiner pointed to the Abstract, FIG. 13, Col. 20, lines 21-52 of O'Brien for supporting the rejection. However, none of these locations referenced by the Examiner teach the claim – the Abstract talks generally about "Internet-based file storage, retrieval, access, control, and manipulation for a user."; FIG. 13 depicts "a Windows™ desktop display showing both the client and web-browser applications." (Col. 5, lines 14-15); and the text in Col. 20 references FIG. 13 and "directory structures of web-based application window 1350 and the client-based application window 1320." In fact, a careful reading and examination of the entire reference does not yield any

discussion of the folders as provided in claim 29 or any mechanism to enable such folders.

As set forth in the Background section of the patent application, systems such as O'Brien "typically use databases to store information about users and the rights of those users to certain files in a system. As such, anytime a user attempts to access a particular file, a database check will be made to determine if the user has rights to that file." (Page 2, lines 24-25). It is apparent that O'Brien uses such conventional methods. O'Brien teaches "bifurcating the file information in databases 152 separate from the actual files themselves on the NFS disk arrays 150, file information and user queries can be handled much more quickly as display components of the present invention are important to provide the user information regarding the status and availability of the files stored on the X:Drive system 100." (Col. 8, lines 31-37). O'Brien further teaches, "[t]he X:Drive system 100 stores file metadata (such as directory structure, file name, file attributes, etc.) in the database 152 for fast retrieval, sorting, searching, linking, and other capabilities beyond standard file systems." (Col. 11, line 66 to Col. 12, line 2)

As O'Brien states in its Abstract, "The user's account may be password protected so that only the user may access his or her files." Further, O'Brien teaches a "SessionSecurity object 224 [that] uses web logic session mechanisms to create the UserData object 230.... The SessionSecurity object 224 authenticates a user's login...." (Col. 10, lines 24-29). Although O'Brien does say that "[t]he user can ...even give permission to share files on the Shared Internet Storage Resource with others," the permission is implemented and evaluated in the form of business rules and not as a received folder and friends folder as claimed. (Col. 11, lines 9-12).

It is clear that O'Brien does not teach in any manner or form the elements of claim 29. It is impermissible to make the quantum leap from an Internet-based file storage system disclosed by O'Brien to the claim limitations without any teaching or suggestion. In fact, nothing in O'Brien can even be twisted to provide a teaching of the received and friends folders in claim 29. Therefore, the rejection is not supported by the O'Brien and should be withdrawn.

Claims 30 and 31, which were also rejected for the same reasons, depend from claim 29. Claims 30 and 31 set forth additional limitations. Claim 30 and 31 are patentable over O'Brien for the same reasons as provided above.

Rejections Under 35 U.S.C. §103

CLAIM 1

Independent claim 1 was rejected under 35 U.S.C. § 103(a) as being anticipated by O'Brien and Mishra (6,389,589). This rejection is respectfully traversed. Applicants traverse this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to claim 1. Claim 1 cites,

A method for configuring an internet file system, the method comprising:
accessing, by a user, a server that is configured with an application;
creating, by the application, an internet file system for the user;
storing, by a directory, a home folder of the user, wherein folders and files in the home folder are available at a root of the internet file system;
providing, by the application, a first folder and a second folder in a root of the home folder, the first folder containing folders that represent folders and files that have been shared with the user, and the second folder containing objects of the user and communities that are of interest to the user; and
creating, by the application, an auxiliary class containing a first attribute, a second attribute, and a third attribute, wherein the first attribute is used to quickly find other users that the folders and the files in the home folder have been shared with, the second attribute is used to store names of the other users and a path of the folders and the files that have been shared with the user, and the third attribute is used to allow the user and other users with common interests to share folders and files of the common interest.

The MPEP § 2142 provides:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that, in the present case, the Examiner has not factually supported a *prima facie* case of obviousness. O'Brien provides a database that may be searched for Internet-based files. Mishra, on the other hand, provides an application deployment management system. (See Col. 9, line 39 - Col. 10, line 35). In particular, Mishra provides for,

[I]f application management is set up for a group policy,..., a class store 70 is created under the group policy 66_B, essentially to store the state of deployment of managed applications....As described in detail below, via the policy 68_B and the associated class store 70, applications and components may be assigned to a policy recipient comprising a group of users, individual users, or to individual computers of a directory container such as the organizational unit 66_B. (Col. 5, lines 8-11; Col. 5, lines 60-65).

It is clear to see that Mishra permits an organization to manage access to its applications, and as such it is not a mechanism to allow a user to share files with other users. Therefore, neither reference provide the teachings of the limitations in claim 1. This rejection should therefore be withdrawn.

1. Alone or Combined, the References Do Not Teach the Claimed Subject Matter

O'Brien and Mishra cannot be applied to reject claim 1 under 35 U.S.C. § 103 which provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither O'Brien nor Mishra teach providing a first folder and a second folder, and creating an auxiliary class as is claimed in claim 1, it is impossible to render the subject matter of claim 1 as a whole obvious, and the explicit terms of the statute cannot be met.

Thus, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

2. Prior Art That Teaches Away From the Claimed Invention Cannot be Used to Establish Obviousness

It may be seen that O'Brien, by providing a database that stores the "metadata" associated with the files for searching purposes, teaches away from the limitations of claim 1. Mishra, which teaches a class store schema, does not remedy O'Brien.

Since it is well recognized that teaching away from the claimed invention is a *per se* demonstration of lack of *prima facie* obviousness, it is clear that the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

Thus, for this reason alone, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection of claim 1 under 35 U.S.C. §103 should be withdrawn.

3. The Combination of References is Improper

Assuming, *arguendo*, that none of the above arguments for non-obviousness apply (which is clearly not the case based on the above), there is still another, mutually exclusive, and compelling reason why O'Brien and Mishra cannot be applied to reject claim 1 under 35 U.S.C. § 103.

§ 2142 of the MPEP also provides:

...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.

Neither O'Brien nor Mishra teaches, or even suggests, the desirability of the combination as neither reference even teach the claimed elements in claim 1.

The MPEP further provides at § 2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

Courts have also repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The Examiner's statement that "[t]he motivation to combine the centralized class store with the method for configuring an Internet file system is apparent in that the LDAP directories are designed to manage network resources, and the O'Brien method comprises an X-Drive, (Fig. 13), which is a network resource" is precisely contrary to the guidance provided by the MPEP and the courts.

Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection and the rejection should be withdrawn.

Similarly rejected claims 2 and 3 depend from claim 1 and are also allowable for at least the reasons set forth above.

CLAIM 8

Independent claim 8 was also rejected under 35 U.S.C. § 103(a) as being anticipated by O'Brien and Mishra. This rejection is respectfully traversed. Applicants traverse this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to claim 8. Claim 8 cites,

A method for file sharing, the method comprising:
sharing, by a first user, a file with a second user;
adding, by an application, the first user to a third attribute of the second user;
adding, by the application, the second user to a third attribute of the first user;
adding, by the application, a path of the shared file and a user name of the second user to a first attribute of the first user;
adding, by the application, the path of the shared file and a user name of the first user to a second attribute of the second user; and
making available, by the application, the first attribute through a folder of the second attribute, wherein the folder belongs to the second user.

The MPEP § 2142 provides:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness and the rejection should be withdrawn.

1. Alone or Combined, the References Do Not Teach the Claimed Subject Matter

The O'Brien and Mishra patents cannot be applied to reject claim 1 under 35 U.S.C. § 103 which provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. It has been established that O'Brien teaches the use of a metadata database to search for available files, which is contrary to claim 8. Further, Mishra teaches an application-centric system that deploy applications to a user depending on the user's profile indicating whether the

application can be accessed by the user. These references, either alone or combined, do not teach or suggest the elements of claim 8. Since neither O'Brien nor Mishra teach providing a first folder and a second folder, and creating an auxiliary class as is claimed in claim 8, it is impossible to render the subject matter of claim 8 as a whole obvious, and the explicit terms of the statute cannot be met.

Thus, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

2. Prior Art That Teaches Away From the Claimed Invention Cannot be Used to Establish Obviousness

It may be seen that O'Brien, by providing a database that stores the "metadata" associated with the files for searching purposes, teaches away from the limitations of claim 8. Mishra, which teaches a class store schema, does not remedy O'Brien's deficiencies.

Since it is well recognized that teaching away from the claimed invention is a *per se* demonstration of lack of *prima facie* obviousness, it is clear that the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

Thus, for this reason alone, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection of claim 8 should be withdrawn.

3. The Combination of References is Improper

Assuming, *arguendo*, that none of the above arguments for non-obviousness apply (which is clearly not the case based on the above), there is still another, mutually exclusive, and compelling reason why O'Brien and Mishra cannot be applied to reject claim 8 under 35 U.S.C. § 103.

§ 2142 of the MPEP also provides:

...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.

Neither O'Brien nor Mishra teaches, or even suggests, the desirability of the combination as neither reference even teach the claimed elements in claim 8.

The MPEP further provides at § 2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

Courts have also repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The Examiner's statement that "[t]he motivation to combine the centralized class store with the method for configuring an Internet file system is apparent in that the LDAP directories are designed to manage network resources, and the O'Brien method comprises an X-Drive, (Fig. 13), which is a network resource" is precisely contrary to the guidance provided by the MPEP and the courts.

Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection and the rejection should be withdrawn.

Claims 11-17 depending from independent claim 8 were also rejected over O'Brien and Mishra. Applicants respectfully submit that the rejection should also be withdrawn with respect to these dependent claims and claims 11-17 are allowable for at least the reasons set forth above.

CLAIM 25

Independent claim 25 was also rejected under 35 U.S.C. § 103(a) over O'Brien and Mishra. Applicants traverse this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness with respect to claim 25. Claim 25 cites,

A system for configuring an internet file system, the system comprises:
a server configured with an application, wherein a user accesses the application and the application creates an internet file system for the user; and
a directory that stores a home folder of the user, wherein folders and files in the home folder are available at a root of the internet file system, wherein the application further provides a plurality of folders in a root of the home folder, and wherein the application further creates an auxiliary class containing a plurality of attributes.

The MPEP § 2142 provides:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness. O'Brien provides a database that may be searched for Internet-based files. Mishra provides an application deployment management system. (See Col. 9, line 39 - Col. 10, line 35). Neither provide the teaching of the limitations in claim 25. This rejection should therefore be withdrawn.

1. Alone or Combined, the References Do Not Teach the Claimed Subject Matter

The O'Brien and Mishra patents cannot be applied to reject claim 25 under 35 U.S.C. § 103 which provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, neither O'Brien nor Mishra teach providing "a server configured with an application, ... the application creates an internet file system for the user; and a directory that stores a home folder of the user, wherein folders and files in the home folder are available at a root of the internet file system, ... and wherein the application further creates an auxiliary class containing a plurality of attributes." Therefore, O'Brien and Mishra does not render the subject matter of claim 25 as a whole obvious.

Thus, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

2. Prior Art That Teaches Away From the Claimed Invention Cannot be Used to Establish Obviousness

It may be seen that O'Brien, by providing a database that stores the "metadata" associated with the files for searching purposes instead of providing a directory that stores a home folder of the user, teaches away from the limitations of claim 25. Mishra, which teaches an application assignment scheme that provides a user profile that indicates applications assigned to the user, also teaches away from claim 25.

Since it is well recognized that teaching away from the claimed invention is a *per se* demonstration of lack of *prima facie* obviousness, it is clear that the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

Thus, for this reason alone, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection of independent claim 25 should be withdrawn.

3. The Combination of References is Improper

Assuming, arguendo, that none of the above arguments for non-obviousness apply, there is still another, mutually exclusive, and compelling reason why O'Brien and Mishra cannot be applied to reject claim 25 under 35 U.S.C. § 103.

§ 2142 of the MPEP also provides:

...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.

Neither O'Brien nor Mishra teaches, or even suggests, the desirability of the combination as neither reference even teach the claimed elements in claim 25.

The MPEP further provides at § 2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

Courts have also repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. As stated above, the Examiner's statement supporting the motivation for combining the references follows precisely the prohibition of the reasoning "the references are combined because they can be combined." Thus, it is clear that neither patent provides any

incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection and the rejection should be withdrawn.

Similarly rejected claims 26 and 27 depend from independent claim 25. Claim 26 further provides “a first folder containing folders that represent folders and files that have been shared with the user, and a second folder containing objects of the user and communities that are of interest to the user.” Claim 27 sets forth “a first attribute used to quickly find other users that the folders and the files in the home folder have been shared with, a second attribute used to store names of the other users and a path of the folders and the files that have been shared with the user, and a third attribute used to allow the user and other users with common interests to share folders and files of the common interest.” These limitations are not found in either references or in their combination. Claims 26 and 27 are therefore also allowable.

CLAIM 28

Independent claim 28 was similarly rejected under 35 U.S.C. § 103(a) over O’Brien and Mishra. Applicants traverse this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to claim 28. Claim 28 cites,

A system for file sharing, the system comprises:
means for sharing, by a first user, a file with a second user;
means for adding, by an application, the first user to a third attribute of the second user;
means for adding, by the application, the second user to a third attribute of the first user;
means for adding, by the application, a path of the shared file and a user name of the second user to a first attribute of the first user;
means for adding, by the application, the path of the shared file and a user name of the first user to a second attribute of the second user; and
means for making available, by the application, the first attribute through a folder of the second attribute, wherein the folder belongs to the second user.

The MPEP § 2142 provides:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that, in the present case, the examiner has not supported a prima facie case of obviousness. O'Brien provides a database that may be searched for Internet-based files. Mishra provides an application deployment management system. (See Col. 9, line 39 - Col. 10, line 35). Neither provide the teaching of the limitations in claim 28. This rejection should therefore be withdrawn.

1. Alone or Combined, the References Do Not Teach the Claimed Subject Matter

35 U.S.C. § 103 provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither O'Brien nor Mishra teach "means for adding...the first user to a third attribute of the second user; means for adding...the second user to a third attribute of the first user; means for adding...a path of the shared file and a user name of the second user to a first attribute of the first user; and means for making available...the first attribute through a folder of the second attribute..." as is claimed in claim 28, it is impossible to render the subject matter of claim 28 as a whole obvious.

Thus, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

2. Prior Art That Teaches Away From the Claimed Invention Cannot be Used to Establish Obviousness

It may be seen that O'Brien, by providing a database that stores the "metadata" associated with the Internet-based files for searching purposes, teaches away from the limitations of claim 28. Mishra, which teaches a class store schema that manages the deployment of applications, does not remedy O'Brien.

Since it is well recognized that teaching away from the claimed invention is a *per se* demonstration of lack of *prima facie* obviousness, it is clear that the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness. Thus, for this reason alone, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection of claim 28 under 35 U.S.C. §103 should be withdrawn.

3. The Combination of References is Improper

Assuming, *arguendo*, that none of the above arguments for non-obviousness apply, there is still another, mutually exclusive, and compelling reason why O'Brien and Mishra cannot be applied to reject claim 28 under 35 U.S.C. § 103.

§ 2142 of the MPEP also provides:

...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.

Neither O'Brien nor Mishra teaches, or even suggests, the motivation for the combination. The MPEP further provides at § 2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

Courts have also repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The Examiner's statement that "[t]he motivation to combine the centralized class store with the method for configuring an Internet file system is apparent in that the LDAP directories are designed to manage network resources, and the O'Brien method comprises an X-Drive, (Fig. 13), which is a network resource" is contrary to the guidance provided by the MPEP and the courts and cannot be used to support this rejection.

Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection and the rejection should be withdrawn.

CLAIM 32

Independent claim 32 was also rejected under 35 U.S.C. § 103(a) over the O'Brien-Mishra combination. This rejection is respectfully traversed. Claim 32 cites,

A directory comprises:
a user object;
a home folder of the user, wherein the home folder is an attribute of the user object;
an auxiliary class attached to the user object when files are shared with the user;
a community folder that includes topics of interest to the user; and
a group object associated with each topic of interest.

The MPEP § 2142 provides that the Examiner “bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” Applicants respectfully submit that the Examiner has failed to do so. O’Brien provides a database that may be searched for Internet-based files. Mishra provides an application deployment management system. (See Col. 9, line 39 - Col. 10, line 35). Neither provide the teaching of the limitations in claim 32. This rejection should therefore be withdrawn.

1. Alone or Combined, the References Do Not Teach the Claimed Subject Matter

O’Brien and Mishra cannot be applied to reject claim 32 under 35 U.S.C. § 103 which provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither O’Brien nor Mishra teach a home folder, an auxiliary class, a community folder, and a group object as set forth in claim 32, it is impossible to render the subject matter of claim 32 as a whole obvious. Therefore, the explicit terms of the statute is not met. For this reason, the Examiner’s burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

2. Prior Art That Teaches Away From the Claimed Invention Cannot be Used to Establish Obviousness

It may be seen that O’Brien and Mishra both teach away from the limitations of claim 32. Since it is well recognized that teaching away from the claimed invention is a *per se* demonstration of lack of *prima facie* obviousness, it is clear that the examiner has not borne the initial burden of

factually supporting any *prima facie* conclusion of obviousness. Thus, for this reason alone, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection of claim 32 under 35 U.S.C. §103 should be withdrawn.

3. The Combination of References is Improper

Assuming, *arguendo*, that none of the above arguments for non-obviousness apply, there is still another, mutually exclusive, and compelling reason why O'Brien and Mishra cannot be applied to reject claim 32 under 35 U.S.C. § 103.

Neither O'Brien nor Mishra teaches, or even suggests, the motivation to combine the references. Courts have also repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The Examiner's statement that "[t]he motivation to combine the centralized class store with the method for configuring an Internet file system is apparent in that the LDAP directories are designed to manage network resources, and the O'Brien method comprises an X-Drive, (Fig. 13), which is a network resource" is directly contrary to the guidance provided by the MPEP and the courts.

Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection and the rejection should be withdrawn.

Claim 33 depends from independent claim 32 and is therefore patentable for the same reasons as set forth above.

CLAIM 34

Independent claim 34 was also rejected under 35 U.S.C. § 103(a) over O'Brien and Mishra. This rejection is respectfully traversed. Claim 34 cites,

A software application executable on a computer, the application comprising:
creating a user internet file system;
providing files in a root of a user's home folder; and
creating an auxiliary class attached to an object of the user if the files are shared via
the internet file system.

The MPEP § 2142 provides that the Examiner "bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." Applicants respectfully submit that the Examiner has failed to do so. O'Brien provides a database that may be searched for Internet-based files. Mishra provides an application deployment management system. (See Col. 9, line 39 - Col. 10, line 35). Neither provide the teaching of the limitations in claim 34. This rejection should therefore be withdrawn.

1. Alone or Combined, the References Do Not Teach the Claimed Subject Matter

35 U.S.C. § 103 provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither O'Brien nor Mishra teach "creating a user internet file system; providing files in a root of a user's home folder; and creating an auxiliary class attached to an object of the user..." as set forth in claim 34, it is impossible to render the subject matter of claim 34 as a whole obvious. Therefore, the explicit terms of the statute is not met. For this reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

2. Prior Art That Teaches Away From the Claimed Invention Cannot be Used to Establish Obviousness

It may be seen that O'Brien and Mishra both teach away from the limitations of claim 34. Since it is well recognized that teaching away from the claimed invention is a *per se* demonstration of lack of *prima facie* obviousness, it is clear that the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness. Thus, for this reason alone, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection of claim 34 under 35 U.S.C. §103 should be withdrawn.

3. The Combination of References is Improper

Assuming, *arguendo*, that none of the above arguments for non-obviousness apply, there is still another, mutually exclusive, and compelling reason why O'Brien and Mishra cannot be applied to reject claim 34 under 35 U.S.C. § 103.

Neither O'Brien nor Mishra teaches, or even suggests, the motivation to combine the teaching in the references. Courts have also repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The Examiner's statement that "[t]he motivation to combine the centralized class store with the method for configuring an Internet file system is apparent in that the LDAP directories are designed to manage network resources, and the O'Brien method comprises an X-Drive, (Fig. 13), which is a network resource" is directly contrary to the guidance provided by the MPEP and the courts.

Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection and the rejection should be withdrawn.

CLAIM 18

Independent claim 18 was rejected under 35 U.S.C. § 103(a) as being anticipated by O'Brien and Mishra, and further in view of "Role-Based Access Control" by Ferraiolo et al. (the "Ferraiolo reference"). This rejection is respectfully traversed. Applicants traverse this rejection on the grounds that these references do not establish a *prima facie* case of obviousness with respect to claim 18. Claim 18 cites,

A method for creating user objects in a directory, the method comprising:
if a user shares a folder with another user who is not registered with an application in the directory, creating a temporary user object with an email address as a name of the another user;
submitting, by the another user, a registration form;
determining, by a script, if the email address corresponds with the another user; and
if the email address corresponds with the another user, updating the temporary user object based on information provided in the registration form.

The MPEP § 2142 provides:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

Applicants respectfully submit that the Examiner has not factually supported a *prima facie* case of obviousness. As discussed above, O'Brien provides a database that may be searched for Internet-based files. Mishra provides an application deployment management system. (See Col. 9, line 39 - Col. 10, line 35). The Ferraiolo reference provides for allowing access to resources based on a user's defined role not his/her identity. Indeed, the Examiner is misguided in using the Ferraiolo reference as a basis of this rejection.

The Ferraiolo reference provides that “DAC is an access control mechanism that permits system users to allow or disallow other users access to objects under their control...based on the identity of subjects and/or groups to which they belong.” (Bottom of Page 2). “A DAC mechanism allows users to grant or revoke access to any of the objects under their control without the intercession of a system administrator.” (Top of Page 3). DAC, as pointed out by the authors, is *fundamentally different* from a role-based access control policy (RBAC) because in RBAC, “users cannot pass access permission on to other users at their discretion.” (Page 3, third full paragraph). The Ferraiolo reference then goes on to discuss RBAC in more detail and does not provide any further guidance on DAC. In forming the rejection of claim 18, the Examiner pointed to page 4 of the Ferraiolo reference that further discusses RBAC. By doing so, the Examiner is essentially citing a contrary teaching to reject claim 18.

Therefore, none of the references either alone or in combination provide the teaching of the limitations in claim 18. This rejection should therefore be withdrawn.

1. Alone or Combined, the References Do Not Teach the Claimed Subject Matter

O’Brien, Mishra and the Ferraiolo reference cannot be applied to reject claim 18 under 35 U.S.C. § 103 which provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since none of the references teach creating a temporary user object with an email address, submitting a registration form, determining if the email address corresponds with the another user, and updating the temporary user object as is claimed in claim 18, it is impossible to

render the subject matter of claim 18 as a whole obvious, and the explicit terms of the statute cannot be met.

Thus, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

2. Prior Art That Teaches Away From the Claimed Invention Cannot be Used to Establish Obviousness

It may be seen that O'Brien, by providing a database that stores the "metadata" associated with the files for searching purposes, Mishra, by providing a way to manage the deployment of applications for users or groups, and the Ferraiolo reference, by teaching role-based access, all teach away from the limitations of claim 18. None of these references teach "a user shar[ing] a folder with another user," but instead teach how to prevent unauthorized access in different ways. These references are therefore contrary to the claim in spirit or substance.

Since it is well recognized that teaching away from the claimed invention is a *per se* demonstration of lack of *prima facie* obviousness, it is clear that the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

Thus, for this reason alone, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection of claim 18 under 35 U.S.C. §103 should be withdrawn.

3. The Combination of References is Improper

Assuming, arguendo, that none of the above arguments for non-obviousness apply, there is still another compelling reason why O'Brien, Mishra and the Ferraiolo reference cannot be applied to reject claim 18 under 35 U.S.C. § 103.

§ 2142 of the MPEP also provides:

...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.

None of the references teach or even suggest the desirability of the combination.

The MPEP further provides at § 2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

Courts have also repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. Again, just because the references can be combined does not create a motivation to combine the references if such motivation or suggestion is lacking in the references.

Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection and the rejection should be withdrawn.

Claims 21-24 depend from independent claim 18 and provide additional limitations thereto. Claims 21-24 are therefore also allowable for at least the reasons set forth above.

CLAIMS 4-7

Claims 4-7 depend from independent claim 1 and were rejected under 35 U.S.C. § 103 over the O'Brien, Mishra and Ferraiolo combination. This rejection is respectfully traversed. In view of

the remarks set forth above in association with the allowability of claim 1, the addition of the Ferraiolo reference does not fill in the large gaps left by O'Brien and Mishra.

Thus claims 4-7, which depend from independent claim 1, are allowable over the art as combined for at least the same reasons as set forth above.

CLAIMS 9 and 10

Claims 9 and 10 depend from independent claim 8 and were also rejected under 35 U.S.C. § 103 over the O'Brien, Mishra and Ferraiolo combination. This rejection is respectfully traversed. In view of the remarks set forth above in association with the allowability of claim 8, the addition of the role-based access of the Ferraiolo reference does not remedy the severe deficiencies left by O'Brien and Mishra.

Thus claims 9 and 10, which depend from independent claim 8, are allowable over the art as combined for at least the same reasons as set forth above.

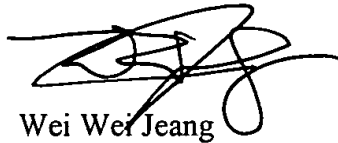
Application No. 09/685,238

Attorney Docket No. 26530.18
Customer No. 27683

Conclusion

It is clear from all of the foregoing that claims 1-34 pending in this application are allowable.
An early formal notice of allowance of the claims is respectfully requested.

Respectfully submitted,



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